UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,813	11/13/2001	Alistair William McLean	1263.2129	6204

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EXAMINER
HANNE, SARA M

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/986,813	MCLEAN, ALISTAIR WILLIAM
	Examiner	Art Unit
	Sara M Hanne	2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.
2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-63* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-63* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on *11/3/01* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/11/02, 10/24/02,*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *IDS 11/19/02*.

U.S. Patent and Trademark Office
PTOL-326 (Rev. 1-04)   Office Action Summary   Part of Paper No./Mail Date 20011113

DETAILED ACTION

Claim Objections

1.   Claim 2 is objected to because of the following informalities: the limitation

" a preference for provider providing preference data" (Claim 2, line 25) appears

to be a typographical error. The examiner believes the limitation is meant to be

read "a preference provider for providing preference data" and treats the claim as

such for examination purposes. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 5 and 15-17, 35, 45-47 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention.

Regarding Claims 5 and 35, the phrase "such as" renders the claim

indefinite because it is unclear whether the limitations following the phrase are

part of the claimed invention. See MPEP § 2173.05(d). Regarding Claims 15

and 45, the alternative limitation "plurality of separate program modules or

fitters." Is improper.   See MPEP § 2173.05(h). Claims 16-17 and 46-47 are

rejected upon their dependency on Claims 15 and 45.

4.   Claims 17, 23-26 and 47 are further rejected under 35 U.S.C. 112, second

paragraph, as being indefinite in that it fails to point out what is included or

excluded by the claim language. This claim is an omnibus type claim.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors

Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology

Technical Amendments Act of 2002 do not apply when the reference is a U.S.

patent resulting directly or indirectly from an international application filed before

November 29, 2000. Therefore, the prior art date of the reference is determined

under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C.

102(e)).

6.   Claims 1-18, 23-58 and 60-63 are rejected under 35 U.S.C. 102(e) as

being anticipated by Foster, US Patent 6211870.

As in Claims 1-2, 27-28, 31-32, 48-49 and 60-63, Foster teaches a user-

interface apparatus, method and system for communicating with a network of

processor-controlled machines to enable the user of the user interface to cause a

processor-controlled machine to carry out a function ("a hand-held, portable

device which can be used by a user to issue commands to a multimedia

processing unit which the multimedia processing unit will recognize and result in

a predetermined change of performance", Column 4, lines 33-36) through a

network (Figure 1), a receiver for receiving device description data provided by

the processor-controlled machine to defining the functional capabilities of that

processor-controlled machine (Figures 6-7 and corresponding text), a user

interface element accessor for accessing user interface element data defining

user interface elements that can be used to form a user interface (Figure 10, refs.

1052 and 1065), an associator for associating the functional capabilities in the

received device description data with user interface elements defined by the user

interface element data (Figure 10, refs. 1060 and 1065 and corresponding text)

and a generator for generating user interface data defining a user interface using

the user interface element data for the user interface elements associated with

the functional capabilities defined by the device description data (Development

Phase, Column 10 line 28 et seq.), a functional capability associated with two

possible alternative user interface elements (soft key or programmable keys,

Column 10, lines 62-63), providing preference data regarding user interface

element preferences ("modify the shape and location of soft keys, ... change text

labels, and otherwise edit the appearance of the screen object", Column 10, lines

61-64) and determining, using the user interface element option data and the

preference data, the user interface elements to be used to represent the

functional capabilities of a processor-controlled machine (Column 11, lines 8-13)

and a functioner for carrying out a function ("a message which can be recognized

by a multimedia processing unit as an instruction to change a particular setting of

the multimedia processing unit.", Column 4, lines 48-50).

As in Claims 3 and 33, Foster teaches the preference provider is operable to provide preference data defining preferences of at least one of the user of the user interface apparatus and the supplier of the user interface apparatus (the user controls the development phase, Column 10, line 28 et seq.).

As in Claims 4 and 34, Foster teaches the preference provider is operable to provide preference data defining at least one of preferences for different types of user interface elements, preferences for the style of presentation of user interface elements and preferences for layout of user interface elements ("modify the shape and location of soft keys, ... change text labels, and otherwise edit the appearance of the screen object", Column 10, lines 61-64).

As in Claims 5 and 35, Foster teaches preference data defining preferences for different types of user interface elements such as button user interface elements and user interface element style preferences such as font to be used for user interface elements (Column 10, lines 50-64 and Figure 10, Ref. 1050, 1052).

As in Claims 6 and 36, Foster teaches the apparatus having a display for displaying the graphical user interface to a user (Figure 8).

As in Claims 7 and 37, Foster teaches a user interface data supplier for supplying generated user interface data to a user interface device (Column 12, lines 2-12).

As in Claims 8 and 38, Foster teaches the communicator operable to communicate with a number of different processor-controlled machines and the receiver operable receive device description data provided by any of different

processor-controlled machines and defining the functional capabilities of that processor-controlled machine (as in Figure 9, the TV and Cable data have been received).

As in Claims 9 and 39, Foster teaches the communicator operable to communicate directly with a processor-controlled machine (Column 11, lines 63-67).

As in Claims 10 and 40, Foster teaches the communicator operable to communicate with a processor-controlled machine via a network to which the processor-controlled machine is coupled (Figure 1).

As in Claims 11 and 41, Foster teaches the receiver operable to receive device description data via the communicating means (Figures 5-6 and corresponding text).

As in Claims 12, 23-24, 26 and 42, Foster teaches the receiver operable to receive device description data directly from a processor-controlled machine (Figures 5-6 and corresponding text) or a network of processor-controlled machines (TV and Cable).

As in Claims 13, 25, 30, 43 and 51 Foster teaches the receiver operable to access device description data using a look-up service provided by a network to which the processor-controlled machine is coupled (Column 8, lines 26-39).

As in Claims 14 and 44, Foster teaches the user interface definer is provided by a processor and associated memory storing a user interface application implementable by the processor (Column 4, lines 54-67).

As in Claims 15 and 45, Foster teaches the user interface application comprising several separate program modules (Figure 10).

As in Claims 16-17 and 46-47, Foster teaches the communicator, receiver, user interface element accessor, associator, and generator comprise respective different program modules (each have their own code associated with controlling that aspect).

As in Claim 18, Foster teaches a processor controlled machine for use with a user interface apparatus having a functioner for carrying out a function ("a message which can be recognized by a multimedia processing unit as an instruction to change a particular setting of the multimedia processing unit.", Column 4, lines 48-50), a machine communicator for communicating with the user interface device to enable the user of the user interface to cause the processor-controlled machine to carry out a function, and a device description data provider for providing device description data defining the functional capabilities of the processor-controlled machine (See Claim 1 rejection *supra*).

As in Claim 29, Foster teaches the user interface display provided by a separate user interface device and the user interface apparatus has a user interface data supplier for supplying the user interface data to the user interface device via the network (Figure 8 and the Transfer Phase, Column 11, line 35 et seq.).

As in Claim 50, Foster teaches the processor means comprises part of the user interface device (See Figure 8 and corresponding text).

As in Claims 52 and 55, user settable data handling parameter defining

means having a parameter (ie. volume or channel) settable by a user

(depressing the corresponding button) and data handling means for handling

received data in accordance with at least one data handling parameter set by the

user (function carried out by the multimedia processing unit under controls set by

the remote).

As in Claims 53 and 56, the data handling means is operable to divert an

incoming message so that the user is not made aware of the message (mute).

As in Claims 54 and 57, the data handling means is operable to send

received data to a location determined by a parameter set by the user

(corresponding multimedia processing unit currently being controlled by the

interface).

As in Claim 58, a user interface modifying means for modifying the user

interface in response to data identifying the availability of another processor-

controlled machine (ie. the TV interface has been created and the Cable

interface is begun as seen in the transition from Figure 7 to Figure 9).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

Claims 19-22 and 59 are rejected under 35 U.S.C. 102(e) as anticipated

by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Foster, US

Patent 6211870. It appears that the "printer", "facsimile", "copying function" and

"scanning function"s are inherently included in Foster teaching of "controllable

multimedia processing units" because printers, fax machines, copiers and

scanners are media transmission devices. Even if it is not, the limitation of

controlling a "printer", "facsimile", "copying function" and "scanning function" is

well known. One of ordinary skill in the art would have been to motivated to

make such a combination because document processing controller interface

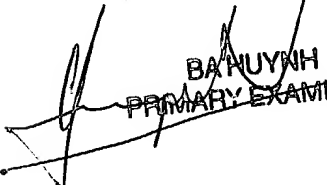would have been obtained.

Conclusion

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar processor-controlled devices networked to controllable and customizable interfaces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M Hanne whose telephone number is (703) 305-0703. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh

BA HUYNH
PRIMARY EXAMINER